

III. Remarks

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Claims 1 – 29 are currently pending in the present application. Claims 1, 20-22, 24 and 27 are currently amended, and claims 28 and 29 are currently canceled without prejudice or disclaimer. In addition, new claims 30 and 31 are currently added. Thus, claims 1-27, 30 and 31 remain pending in the present application.

Rejections Under 35 USC §103

Claims 1-16 and 19-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,042,426 to Byrne (“Byrne”) in view of U.S. Patent No. 6,607,408 to Milan (“Milan”) and paragraphs [0028] and [0029] of the present application. Claims 17, 18 and 29 have also been rejected under 35 U.S.C. §103(a) as being unpatentable over Milan in view of U.S. Patent Application Publication No. 2004/0147147 of Griepentrog (“Griepentrog”). However, these rejections are not applicable to claims 1, 20, 21 or 22, among others, for the following, mutually exclusive reasons.

Claim 1

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 1 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Byrne, Milan and Griepentrog, alone or in combination, do not teach an electrical cord, extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing, and a plurality of externally accessible

USB ports each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports, wherein the plurality of downstream USB ports are each configured to communicate with: an accessed one of the first and second upstream USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed. This is also not taught by the present application as being known in the art, as more fully explained below.

Therefore, it is impossible to render the subject matter of claim 1 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Byrne, Milan and Griepentrog cannot be combined and applied to reject claim 1 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Byrne, Milan and Griepentrog do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing an electrical cord, extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing, and a plurality of externally accessible USB ports each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports, wherein the plurality of downstream USB ports are each configured to communicate with: an accessed one of the first and second upstream USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed.

Thus, none of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and the rejection under 35 U.S.C. §103(a) is not applicable.

Dependent claims 2-19 depend from and further limit independent claim 1 in a patentable sense and, therefore, are allowable as well.

Claim 20

Byrne, Milan and Griepentrog, alone or in combination, also do not teach a panel, having an aperture through first and second opposing sides, and a power harness extending through the aperture, including an electrical cord, extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing, a plurality of externally accessible USB ports, each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports, and circuitry interconnecting associated ones of the upstream and downstream USB ports such that accessed ones of the plurality downstream USB ports communicate with: an accessed one of the first and second upstream USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed. This is also not taught by the present application as being known in the art, as more fully explained below.

Therefore, it is impossible to render the subject matter of claim 20 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 20, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Byrne, Milan and Griepentrog cannot be combined and applied to reject claim 20 under 35 U.S.C. §103(a). Here, Byrne, Milan and Griepentrog do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing a panel, having an aperture through first and second opposing sides, and a power harness extending through the aperture, including an electrical cord, extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing, a plurality of externally accessible universal serial bus (USB) ports, each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports, and circuitry interconnecting associated ones of the upstream and downstream USB ports such that accessed ones of the plurality downstream USB ports communicate with: an accessed one of the first and second upstream USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed.

Thus, none of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 20.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 20. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 20, and the rejection under 35 U.S.C. §103(a) is not applicable.

Claim 21

Byrne, Milan and Griepentrog, alone or in combination, also do not teach providing a panel having an aperture through first and second opposing sides, providing a power harness, the power harness including: an electrical cord extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing; a plurality of externally accessible USB ports each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports; and circuitry interconnecting associated ones of the upstream and downstream USB ports such that accessed ones of the plurality downstream USB ports communicate with: an accessed one of the first and second upstream

USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed; and assembling the power harness in the aperture. This is also not taught by the present application as being known in the art, as more fully explained below.

Therefore, it is impossible to render the subject matter of claim 21 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 21, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Byrne, Milan and Griepentrog cannot be combined and applied to reject claim 21 under 35 U.S.C. §103(a). Here, Byrne, Milan and Griepentrog do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing a panel having an aperture through first and second opposing sides, providing a power harness, the power harness including: an electrical cord extending from a housing for delivering electrical power to at least one externally accessible downstream power port at least partially contained in the housing; a plurality of externally accessible universal serial bus (USB) ports each at least partially contained in the housing, the plurality of USB ports including first and second upstream USB ports and a plurality of downstream USB ports; and circuitry interconnecting associated ones of the upstream and downstream USB ports such that accessed ones of the plurality downstream USB ports communicate with: an accessed one of the first and second upstream USB ports when only one of the first and second upstream USB ports is accessed; and a predetermined one of the first and second upstream USB ports when both of the first and second upstream USB ports are accessed; and assembling the power harness in the aperture.

Thus, none of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 21.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 21. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 21, and the rejection under 35 U.S.C. §103(a) is not applicable.

Claim 22

Byrne, Milan and Griepentrog, alone or in combination, also do not teach providing an article of furniture comprising a harness and at least one of first and second panels, the harness including: a stop, a first mechanically biasable member configured to cooperate with the stop to engage a corresponding first thickness of the first panel, a second mechanically biasable member configured to cooperate with the stop to engage a corresponding second thickness of the second panel, wherein the second thickness is substantially greater than the first thickness, and a plurality of externally accessible USB ports each at least partially contained in the harness, the plurality of USB ports including at least one upstream USB port and at least one downstream USB port interconnected with the at least one upstream USB port. This is also not taught by the present application as being known in the art, as more fully explained below.

Therefore, it is impossible to render the subject matter of claim 22 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 22, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why Byrne, Milan and Griepentrog cannot be combined and applied to reject claim 22 under 35 U.S.C. §103(a). Here, Byrne, Milan and Griepentrog do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing an article of furniture comprising a harness and at least one of first and second panels, the harness including: a stop, a first mechanically biasable member configured to cooperate with the stop to engage a corresponding first thickness of the first panel, a second mechanically biasable member configured to cooperate with the stop to engage a corresponding second thickness of the second panel, wherein the second thickness is substantially greater than the first thickness, and a plurality of externally accessible USB ports each at least partially contained in the harness, the plurality of USB ports including at least one upstream USB port and at least one downstream USB port interconnected with the at least one upstream USB port.

Thus, none of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 22.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 22. Therefore, for this mutually exclusive reason, the Examiner's burden

of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 22, and the rejection under 35 U.S.C. §103(a) is not applicable.

Dependent claims 23-27, 30 and 31 depend from and further limit independent claim 22 in a patentable sense and, therefore, are allowable as well.

Response to Examiner's comments

Understanding by those skilled in the art

The Examiner has confirmed that, in accord with paragraph [0028] of the present application, "... those skilled in the art will understand the circuitry [of the present application] by the functional description of the circuitry" However, based on such confirmation, the Examiner has also asserted that it would have been obvious to a person having ordinary skill in the art to modify the Byrne power harness such that it would include:

- USB ports as taught by Milan, and
- the circuitry as taught by the present application.

The Examiner has also asserted that such modifications to the Byrne power harness would have been obvious to those skilled in the art because:

- the resulting power harness would be able to provide variety of connection, and
- a necessary circuitry would be required to provide desired connections between the connector ports.

Applicant respectfully traverses the Examiner's assertion for at least the following, mutually exclusive reasons.

The fact that the functional description of particular circuitry can enable those skilled in the art to understand the circuitry has no bearing on the novelty or obviousness of claims directed towards the circuitry. In contrast, the fact that those skilled in the art would understand particular circuitry merely in view of its functional description affirmatively confirms that the enablement and written description requirements are adequately satisfied, particularly with respect to claims or claim elements directed towards the particular circuitry. However, Applicant appreciates the Examiner's indication that the enablement and written description requirements have been fully satisfied with respect to the present application. Nonetheless, the Examiner's assertion that any claim which is understandable to those

skilled is also necessarily unpatentable is irreconcilable with the patent law's basic tenets of enablement and written description. These requirements mandate that one skilled in the art must be able to make and use the claimed invention based on the specification, the claims and the knowledge in the art. That is, no patents would ever be granted if claims were further required to never be understandable to those skilled in the art.

Applicant respectfully notes that the knowledge possessed by a person having ordinary skill in the art includes that knowledge necessary to make and use two different kinds of circuits. That is, those having ordinary skill in the art have the knowledge necessary to make and use circuits of which they are aware, as well as some circuits for which they have yet to discover functionality. In other words, those having ordinary skill in the art have the knowledge necessary to make and use circuits of known functionality, and also have the knowledge necessary to make and use some circuits of unknown functionality. In this context, paragraph [0028] of the present application merely provides that, upon coming to understand the particular functionality of some circuitry, those skilled in the art have the requisite knowledge to make and use circuitry having such functionality. However, this fact is moot when examining the novelty or obviousness of the circuitry. For example, circuitry having a particular functionality can be novel and/or not obvious, yet still not be understood by those skilled in the art.

Thus, to factually support a *prima facie* case of obviousness of claims reciting circuitry having a particular functionality, the Examiner must show that the particular functionality of the circuitry is known in the art. The fact that those skilled in the art would understand the particular functionality of the circuitry, standing alone, fails to support a *prima facie* case of obviousness. Accordingly, any §103 rejection based on the Examiner's premise regarding whether those skilled in the art would understand the claimed subject matter should be withdrawn.

Duplication of parts

The Examiner has also argued that dependent claims directed towards the specific number of connector ports or mechanically biasable members merely regard a duplication of parts, and that mere duplication of parts was held in the *St. Regis* case to involve only routine skill in the art. However, as held in *In re Warner*, 379 F.2d 1011:

- §103 rejections must rest on a factual basis;
- it is the Examiner's duty to supply the requisite factual basis for such rejections; and

- the Examiner may not, because of doubts regarding patentability, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

In the present case, the Examiner has failed to advance any factual basis to supply the admitted deficiencies of Byrne relative to the claimed subject matter. Instead, the Examiner is attempting to bridge Byrne's evidentiary gaps by resorting to mechanical rules of obviousness allegedly established by the *St. Regis* case. Such rules do not exist, however, and the reliance thereon by the Examiner to establish obviousness is improper. See *In re Ochiai*, 71 F.3d 1565, 1570, 37USPQ2d 1127, 1132 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

Moreover, the false premise that mere duplication of parts involves only routine skill in the art fails to cure the deficiencies of the cited references. For example, as conceded by the Examiner, the cited references collectively fail to teach or suggest each and every element of claim 1, among others. Consequently, the cited references also fail to teach or suggest each and every element of any claim depending from claim 1, including dependent claims which recite additional instances of anything recited in claim 1, even in light of the false premise that mere duplication of parts involves only routine skill in the art. Thus, any §103 rejection based on the Examiner's premise regarding duplication of parts should be withdrawn.

Common knowledge

The Examiner has also argued that it is common knowledge to use ballast to provide stability to an object. However, as provided in §2144.03, it is never appropriate for the Examiner to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Thus, the Examiner's argument is improper in the absence of factual evidence supporting the premise that employing ballast is commonly known to those having skill in the pertinent art.

Nonetheless, in response to the Examiner's argument, the undersigned attempted to locate any prior art reference which might suggest that the claimed arrangement employing ballast is, indeed, common knowledge. However, no patents were identified when searching the online USPTO database for patents having the same classification and sub-classification as the present application, having a filing date prior to the filing date of the present application, including the word "ballast" in the title, abstract, claims or specification, and listing either the Examiner or the Examiner's Supervisor as the examiner. As

further evidence that the claimed arrangement for employing ballast is not common knowledge, Applicant also points to the fact that none of the references of record disclose employing ballast in a similar or analogous manner.

Thus, the prior art fails to support the Examiner's premise that employing ballast in the presently claimed arrangement is common knowledge. Because the record is currently absent any evidentiary support for the Examiner's premise, any §103 rejection based on the premise should be withdrawn.

IV. Conclusion

Reconsideration of this application in light of the above amendments and remarks is respectfully requested.

It is believed that all matters set forth in the Office action have been addressed. Favorable consideration and an early indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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Dated: 12/16/04

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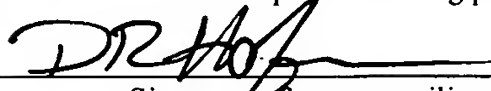
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